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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,442	06/20/2005	Alain Coudurier	COUDURIER2	8064
1444 7590 12/08/2008 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303			EXAMINER ZIMMERMAN, JOHN J	
			ART UNIT 1794	PAPER NUMBER
			MAIL DATE 12/08/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/539,442	Applicant(s) COUDURIER, ALAIN	
	Examiner John J. Zimmerman	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 9/4/2008 and 9/18/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

SECOND OFFICE ACTION

Amendments

1. This Second Office Action is in response to the correspondence titled "AMENDMENT" received September 4, 2008 and the correspondence titled "COMMUNICATION" received September 18, 2008. Claims 1-22 are pending in this application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 3-5 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. It is not clear how a "selected thickness" (e.g. claim 3, line 4; claim 21, line 3) is intended to differ from any other thickness of metallic material on the substrate. It is indefinite as what thicknesses would be considered a "selected" thickness and what thicknesses would not be considered a "selected" thickness. Since the scope of "selected thickness" cannot be determined,

Art Unit: 1794

the term is indefinite in the manner in which it is used in the pending claims. Claims 4-5 are rejected because they depend on claim 3 and incorporate its indefinite matter.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-22 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-7 of copending Application No. 11/856,545 (U.S. Pub. No. 2008/0081211). Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the copending application cover cooking surfaces made of zirconium alloys containing cobalt (e.g. see claim 1 of the copending application) and the pending claims cover cooking surfaces made of zirconium alloys containing at least one other metal. Although it is noted that the pending claims require at least

Art Unit: 1794

75% zirconium in the alloy, the claims of the copending application encompass alloys in this range. Although it is noted that the copending claims require cobalt as an alloying constituent, the pending claims encompass this selection as an alloying constituent. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-22 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Winter (U.S. Patent 3,496,621).

10. Winter discloses an aluminum alloy strip having a roll clad Zircaloy surface (e.g. see Example 5). Zircaloy has a zirconium content of greater than 75% (e.g. pending claim 1) and less than 10% of elements in addition to zirconium (e.g. pending claim 2). While Winter may

Art Unit: 1794

not disclose the alloy as a "kitchen utensil or cooking appliance comprising a utensil or appliance body and a food contacting surface adhered to a surface of said body and constituting a cooking surface" (e.g. claim 1, lines 2-4), no particular structure is required by these terms that could not be said of basic stock material used for Winter's purposes. A "kitchen utensil" or "appliance body" can have any conventional or unconventional configuration. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Stock material or articles made from the alloys of the reference are as capable of being used for a kitchen utensil or cooking appliance as the articles described in the applicant's claims.

Regarding claims requiring a "crystalline metal sheet" (e.g. claim 6), the roll clad Zircaloy sheet of Winter would be crystalline. While it is noted that some pending claims recite that the surface is deposited by sputtering (e.g. claims 4-5) and Winter uses roll cladding, when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton*,

Art Unit: 1794

and Shaw, 195 USPQ 431 (CCPA 1977). Likewise, there is no evidence of record that the method limitations of the remaining article claims (e.g. colaminating, brazing, hot striking, stamping, etc. . .) necessarily result in a patently distinct product from the product of Winter. Winter specifically recites his article and the method recitations in the pending article claims do not necessarily add any further structure that would not be present in the article of Winter.

Response to Arguments

11. Applicant's arguments filed September 4, 2008 have been fully considered but they are not persuasive.

12. Regarding the prior rejection of the claims under 35 U.S.C. 112, second paragraph, as being indefinite since the prior claims failed to properly specify the system used in reciting the percentages of alloying elements (e.g. weight percent, volume percent or atomic percent), applicant's arguments along with the submission in the "COMMUNICATION" (September 18, 2008) are convincing in demonstrating that one of ordinary skill in the art would have understood the system to be weight percent at the time the invention was made.

13. Regarding the rejection of claims 3-5 and 21 under 35 U.S.C. 112, second paragraph, as being indefinite for the phrase "selected thickness" (e.g. claim 3, line 4; claim 21, line 3), applicant argues that the term would indicate to one of ordinary skill in the art that the substrate would be given a thickness suitable for the intended purpose and that this thickness would depend on a number of factors, including deposition techniques, desire to provide a durable

Art Unit: 1794

surface and contrasting desire to minimize the amount of material deposited (e.g. see page 6 of applicant's response). The examiner notes, however, that since the scope of the term "selected thickness" is suggested by applicant to depend of a number of unspecified factors and since no such factors are described in the claims or defined in the specification, there can be no clear understanding of how this term specifically limits the claims. Depending on some unspecified goal of an individual artisan, the "selected thickness" in claims 3 and 21 would be variable and therefore the scopes of these claims cannot be known and are indefinite. Since one of ordinary skill in the art cannot determine what thicknesses would be considered a "selected" thickness and what thicknesses would be excluded as a "selected" thickness, the claims are indefinite.

Applicant's argument that limitations of this type can be found in the claims of issued patents (e.g. see page 7 of applicant's response) is not convincing since interpretation of applicant's pending claims is dependent on the fact situation of the pending application and not the use of the term in unrelated issued patents.

14. Regarding the rejection of the claims under 35 U.S.C. 102(b)/103(a) as anticipated or obvious over Winter, applicant argues that "the recitation of "a utensil or appliance body" as a positively recited element of the claimed device cannot be ignored and must be interpreted according to its plain meaning, which is a body that is constructed and used for cooking" (e.g. see page 9 of applicant's response). The examiner notes that no particular structure is required by these terms that could not be said of the articles disclosed by Winter. A "kitchen utensil" or "appliance body" can have any conventional or unconventional configuration. There is no art recognized ordinary, plain or customary meaning of the terms "kitchen utensil" or "appliance

Art Unit: 1794

body" in the art that would exclude any particular configurations disclosed by Winter. Any configuration that would be produced by Winter could serve a "kitchen utensil" or "appliance body" without modification. The examiner also notes that since the alloys Winter meet the requirements of the alloy composition in the rejected claims, articles produced Winter would be expected to interact in the same manner as applicant's alloy when contacting food being cooked. The thermal characteristics and cleaning properties of Winter's articles would be expected to be the same as those of applicant's articles. Discovery of a new property or use of previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to known composition, *In re Spada*, 15 USPQ2d 1655 (Court of Appeals, Federal Circuit 1990). It is not necessary that applied art recognize the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference, *Verdegaal Bros., Inc. v. Union Oil Co.*, 2 USPQ2d 1051, 1054 (Fed. Cir. 1987).

Conclusion

15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

Art Unit: 1794

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Rena Dye can be reached on (571) 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

John J. Zimmerman
Primary Examiner
Art Unit 1794

/John J. Zimmerman/
Primary Examiner, Art Unit 1794
December 2, 2008